

**WOOD, HERRON & EVANS, L.L.P.**

BRUCE TITTEL  
 DAVID S. STALLARD  
 J. ROBERT CHAMBERS  
 GREGORY J. LUNN  
 KURT L. GROSSMAN  
 CLEMENT M. LUKEN, JR.  
 THOMAS J. BURGER  
 GREGORY F. AHRENS  
 WAYNE L. JACOBS  
 KURT A. SUMME  
 KEVIN G. ROONEY  
 KEITH R. HAUPT  
 THEODORE R. REMAKLUS  
 THOMAS W. HUMPHREY  
 SCOTT A. STINEBRUNER  
 DAVID H. BRINKMAN  
 KRISTI L. DAVIDSON  
 KATHRYN E. SMITH  
 P. ANDREW BLATT, Ph.D.  
 DAVID E. JEFFERIES  
 J. DWIGHT POFFENBERGER, JR.  
 WILLIAM R. ALLEN, Ph.D.  
 JOHN PAUL DAVIS  
 BRETT A. SCHATZ  
 SARAH OTTE GRABER

2700 CAREW TOWER  
 441 VINE STREET  
 CINCINNATI, OHIO 45202-2917  
 TELEPHONE: 513-241-2324  
 FACSIMILE: 513-241-6234  
 WEBSITE: www.whepatent.com  
 PATENT, TRADEMARK, COPYRIGHT  
 AND UNFAIR COMPETITION LAW  
 AND RELATED LITIGATION  
 EDMUND P. WOOD 1923-1968  
 TRUMAN A. HERRON 1935-1978  
 EDWARD B. EVANS 1938-1971

**RECEIVED**  
**CENTRAL FAX CENTER**  
**JAN 27 2009**

DAVID W. DORTON  
 STEVEN W. BENINTENDI, Ph.D.  
 RANDALL S. JACKSON, JR.  
 ADAM R. WEEKS  
 CHARLES R. FIBER, JR.  
 KEVIN E. KUEHN  
 ANA C. JAQUEZ  
 COLIN L. WIER  
 TIMOTHY D. ARDIZZONE, Ph.D.  
 RAMON A. URTEAGA  
 CHASTITY D. S. WHITAKER, Ph.D.  
 HARRY J. GUTTMAN, Ph.D.

OF COUNSEL  
 JOHN D. POFFENBERGER  
 DAVID J. JOSEPHIC  
 DONALD F. FREI  
 THOMAS W. FLYNN  
 JOSEPH R. JORDAN  
 C. RICHARD EBY

PATENT AGENT  
 MICHAEL H. SCHENKER

January 26, 2009

**FACSIMILE COVER SHEET**

<b>To:</b>	<b>Company:</b>	<b>Fax Number:</b>
Examiner Daniel Kesack	US Patent Office Group Unit No. 3691	571-273-8300
<b>Total Pages:</b>	24 (including cover sheet)	
<b>From:</b>	Thomas W. Humphrey	
<b>Re:</b>	i Attorney Docket: MPS-30DV3 US Application Serial No. 09/859,615 Filed May 16, 2001 System and Method For Paying Bills and Other Obligations Including Selective Payor and Payee Controls	

If transmission is interrupted or of poor quality, please notify us immediately by calling LKoehler at (513) 241-2324

OUR FAX NUMBER IS (513) 241-6234.

**Message/Comments**

Attached is an Appeal Brief. Please Apply the Appeal Brief and Extension of Time Fee to Account 23-3000.

Confirmation copy will not follow.

The information in this facsimile message is ATTORNEY-CLIENT PRIVILEGED, WORK PRODUCT and/or CONFIDENTIAL INFORMATION intended only for the use of the individual or entity to whom this message is addressed. If the reader of this message is not the intended recipient or the employee or agent responsible for delivering it to the intended recipient, you are hereby notified that any dissemination, distribution or reproduction of this communication is strictly prohibited. If you have received this communication

**RECEIVED  
CENTRAL FAX CENTER  
JAN 27 2009**

**PATENT  
ATTY. DOCKET NO. MPS-03DV3**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**Ex parte**

**Appeal No. \_\_\_\_\_**

Serial No.: 09/859,615  
Filed: May 16, 2001  
Group Art Unit: 3691  
Examiner: Daniel Kesack  
Applicant: George W. Landry  
Title: System And Method For Paying Bills And Other Obligations  
Including Selective Payor And Payee Controls

Cincinnati, Ohio 45202

January 26, 2009  
*Via Facsimile*

**APPEAL BRIEF**

This brief is in furtherance of Applicant's Notice of Appeal filed August 26, 2008, appealing the decision of the Examiner dated February 26, 2008 finally rejecting claims 25-58. A copy of the claims appears in the Appendix to this brief.

---

*Certificate of Facsimile Transmission*

I hereby certify that this correspondence and any enclosures are being electronically transmitted via facsimile on the date indicated below.

/ Thomas W. Humphrey /  
Thomas W. Humphrey  
Reg. No. 34,353

January 26, 2009  
Date

**Real Party In Interest**

The real party in interest in this appeal is MIDWEST PAYMENT SYSTEMS, an Ohio corporation of having a place of business at 38 Fountain Square Plaza, Cincinnati, Ohio 45263.

**Related Appeals and Interferences**

There are no such appeals or interferences.

**Status of Claims****Total Number of Claims in the Application**

Claims in the application are 25-58.

**Status of all the Claims**

1. Claims cancelled: 1-24
2. Claims withdrawn from consideration but not cancelled: NONE
3. Claims objected to: NONE
4. Claims allowed or confirmed: NONE
5. Claims rejected: 25-58

**Claims on Appeal**

The claims on appeal are Claims 25-58.

**Status of Amendments**

There are no amendments pending.

**Summary of Claimed Subject Matter as to Independent Claim 25**

Independent Claim 25 is described in the specification on page 38, lines 3-18 and Fig. 3, reference numbers 112, 120 and 150, and on page 49, line 11 through page 50, line 2, and Fig. 7 of the drawings.

As recited in claim 25, a bill paying system stores information for payees, and payors, including parameters established for enabling transfers of funds from a payee to a payor by a funds transfer generator. A communication device receives bill data from a plurality of payees and causes an interactive device to present the plurality of transactions representing bills of at least two different payees.

**Summary of Claimed Subject Matter as to Independent Claim 42**

Independent Claim 42 is described in the specification on page 38, lines 3-18 and Fig. 3, reference numbers 112, 120 and 150, and on page 49, line 11 through page 50, line 2, and Fig. 7 of the drawings.

As recited in claim 42, a bill paying method involves storing information for payees, and payors, including parameters established for enabling transfers of funds from a payee to a payor by a funds transfer. Funds transfers are generated based on bill data, and the stored information. The bill data from a plurality of payees is received and is presented on an interactive device.



**Grounds of Rejection**

Claims 25-38, 40-55, 57 and 58 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kight, U.S. Patent No. 5,383,113, in view of Pickering, U.S. Patent No. 5,483,445, as cited in the Final Office Action.

**Argument**

Applicant submits that the Examiner has failed to present a prima facie case of obviousness of the rejected claims based on the cited Kight and Pickering references.

Furthermore, Applicant submits that the Examiner has improperly applied the standard of obviousness in asserting the combination of the cited Kight and Pickering references.

Applicant has argued based on upon the independent claims which stand or fall with the dependent claims for the purposes of this appeal.

**Argument - Rejections under 35 U.S.C. § 103**

Claims 25-38, 40-55, 57 and 58 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kight, U.S. Patent No. 5,383,113, in view of Pickering, U.S. Patent No. 5,483,445, as cited in the Office Action.

Kight discloses a system, developed by Checkfree Corporation, in which "a consumer may instruct a service provider by telephone, computer terminal, or other telecommunications means to pay various bills without the consumer having to write a check for each bill." (Abstract) There is no disclosure in Kight of the consolidation of multiple bills for combined presentation, nor is there disclosure of an interactive device for presenting bills of multiple potential payees. Rather, the flow of information is not from the biller to the Kight system and then to the payor for authorization or review, but rather, from the biller to the payor, and then to the Kight system for initiation of the payment transfer. Note col. 1, line 66 et seq.: "The method of the present invention includes ... the generation of payment instructions by the consumer at a convenient location, typically remote from the payment service provider (e.g., at home), through an input

terminal such as a personal computer, a push-button telephone or other like communication means ... validating each transaction against a dynamic credit file and routing based on set parameters....” Kight is thus a service provider for the actual routing of payment – not a service provider for bill collection. Kight does not in any way suggest collecting bill data from billers for presentation in combination to a payor.

Pickering is a filing made by American Express relating to a “method of consolidating a plurality of individual company charges for a customer...” (Abstract) In this method, a paper statement (see Pickering Fig. 7) is sent to the consumer, listing the payments due. A combined payment and a combined due date is identified (see 77 and 81). The Pickering patent notes that companies may be paid after the due date and would need to be paid a compensatory “float” payment in such cases (col. 10 lines 3-5. However, “it is preferable to determine or calculate the single periodic customer billing date for the company and utility charges that are incurred by the customer in order to minimize the overall compensatory payment or “float” payment rebated to the group of companies and utilities.” (col. 10, lines 30-34 However, it is also possible for the “float” to be paid to the financial firm operating the system, as noted in col. 11 at lines 8-10.

The Examiner seeks to combine Kight and Pickering to achieve the claimed invention. However, this combination fails for at least two reasons.

First, the Examiner does not explain how he would find in either reference a system or method that would undertake the step of “causing an interactive device to present a plurality of transactions representing bills of at least two different payees”, as recited in the claims. Kight lacks any suggestion of presenting bills of multiple billers on an interactive device and Pickering

uses paper to interact with a payor. Lacking these elements the Examiner does not have a prima facie case of obviousness.

Furthermore, the Examiner fails to explain why a person of skill would take the initial step of combining Kight and Pickering, a step that is required for an obviousness analysis.

As noted in Applicant's prior submissions, there is a fundamental incompatibility between Kight and Pickering that belies the Examiner's view that these references would be combined, in any fashion.

Specifically, all payment methods described within the Checkfree/Kight system are

PAGE 12/12 \* RCVD AT 1/27/2009 12:02:46 AM [Eastern Standard Time] \* SVR:USPTO-EFXRF-4/0 \* DNIS:2738300 \* CSID:5137720052 \* DURATION (mm-ss):11-42

**BEST AVAILABLE COPY**